

BS00-079

PATENT



87/Reconsideration
JF
3/25/04

RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP NO.: 2683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

ALAN L. KREGEL

Serial No.: 09/822,332

Filed: April 2, 2001

For: MISSED CALL NOTIFICATION TO
CELLULAR TELEPHONE USING
SHORT TEXT MESSAGING

RECEIVED

MAR 23 2004

Art Unit: 2683

Technology Center 2600

Examiner: CUMMING, William D.

**REQUEST FOR RECONSIDERATION
IN RESPONSE TO OFFICE ACTION DATED MARCH 3, 2004**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the position taken in the Office Action mailed March 3, 2004.

A Petition for a one-month extension of time is being filed concurrently herewith.

It is asserted in this pending Office Action that the "reply filed on February 24, 2004 is not fully responsive to the prior Office Action" in that said reply (an Amendment) failed to address paragraph 10 of the Office Action mailed November 26, 2003. That paragraph required to either cancel conflicting claims (in co-pending application 09/839,217) or maintain a clear line of demarcation between the applications.

Applicant's representative contacted Examiner Cumming by telephone on March 9, 2004 in an effort to resolve what appears to be a misunderstanding regarding the scope of the claims of

the instant application in comparison to the scope of the claims of co-pending application

09/839,217. Examiner Cumming indicated that a written response from the Applicant would be necessary to ultimately resolve the matter.

The instant application, Application No. 09/822,332, is the parent of co-pending Continuation-in-Part application, Application No. 09/839,217. New matter was added to the Continuation-in-Part application, which new matter was then explicitly recited in the claims of the Continuation-in-Part application. Below is a table showing a side-by-side comparison of exemplary original claim 1 of the instant Application No. 09/822,332 and the co-pending Continuation-in-Part application. Differences are highlighted in **bold**.

Application No. 09/839,217 (Continuation-in-Part of 09/822,332) Original Claim 1	Application No. 09/822,332 Original Claim 1	Application No. 09/822,332 Claim 1 As Amended on February 24, 2004
1. A method of providing missed call notification to a cellular telephone, comprising the steps of: (a) receiving a telephone call, which is directed to a cellular telephone, at a central office; (b) forwarding call setup information that is representative of the telephone call from the central office to a SS7 gateway and sending a location request communication to a home location register; (c) receiving an access denied response with a reason code of at least one of MS Inactive, Busy, No Page Response and Unavailable from the home	1. A method of providing missed call notification to a cellular telephone, comprising the steps of: (a) receiving a telephone call, which is directed to a cellular telephone, at a central office; (b) forwarding call setup information that is representative of the telephone call from the central office to a SS7 gateway and sending a location request communication to a home location register; (c) receiving an access denied response with a reason code of inactive from the home location register; (d) generating, in response to	1. (Currently Amended) A method of providing missed call notification to a cellular telephone, comprising the steps of: (a) receiving a telephone call, which is directed to a cellular telephone, at a central office; (b) forwarding call setup information that is representative of the telephone call from the central office to a SS7 gateway and sending a location request communication to a home location register; (e) receiving an access denied response with a reason

location register; (d) generating, in response to step (c), a message at the SS7 gateway including information identifying the origin of the telephone call; (e) sending the message to a message center; and (f) forwarding the message to the cellular telephone when the cellular telephone registers with the home location register, thereby providing notification of a missed call.	step (c), a message at the SS7 gateway including information identifying the origin of the telephone call; (e) sending the message to a message center; and (f) forwarding the message to the cellular telephone when the cellular telephone registers with the home location register, thereby providing notification of a missed call.	code of inactive from the home location register; (d) generating, in response to step (c), a message at the <u>an</u> SS7 gateway including information identifying the origin of the telephone call; (e) sending the message to a <u>short message service (SMS)</u> message center; and (f) forwarding the message to the cellular telephone when the cellular telephone registers with the home location register, thereby providing notification of a missed call.
---	--	---

The highlighted text in the original (and currently pending) claim in the co-pending Continuation-in-Part application recites “receiving an access denied response with a reason code **of at least one of MS Inactive, Busy, No Page Response and Unavailable** from the home location register,” which was not recited in any of the original claims in the instant ‘332 application. Indeed, the recitation of such a limitation was only possible in view of new matter that was added to the Continuation-in-Part application.

It is noted further that the independent claims of the instant ‘332 application have since been amended (as also shown in the table above) to even more clearly modify the scope thereof in comparison to the independent claims of the co-pending Continuation-in-Part application. In particular, the amended claims in the instant ‘332 application no longer recite “sending a location

request communication” and/or “receiving an access denied response.” Thus, the scope of the sets of claims pending therein in comparison to those pending in the instant application is, and has always been, clearly different.

Based on the foregoing, and the same arguments made in the Amendment filed February 24, 2004, there is, in fact, “a clear line of demarcation between the applications,” which is responsive to paragraph 10 of the previous Office Action. As such, Applicant respectfully requests that the position taken in the Office Action mailed March 3, 2004, that the reply filed February 24, 2004 is not responsive, be reconsidered and withdrawn.

Should the Examiner still take the position that a judicially create obviousness-type double patenting rejection is still justified despite the claim amendments in the instant ‘332 application, the Examiner is requested to contact the undersigned so that an appropriate Terminal Disclaimer can be prepared and submitted.

Serial No.: 09/822,332
Art Unit: 2683

Attorney's Docket No.:BS00-079
Page 5

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

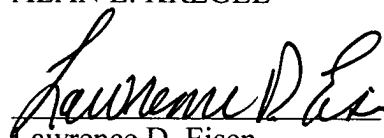
SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703/770-7693

Date: March 18, 2004

Respectfully submitted,

ALAN L. KREGEL

By:


Lawrence D. Eisen
Registration No. 41,009

Customer No. 28970

Document #: 1275963 v.1